

The Examiner states that differences with respect to the manner of forming an element do not distinguish over a prior art device otherwise having the same structural elements. Applicants respectfully submit that claim 52 should not be construed as a product-by-process claim. The word "molded" is a structural distinction since it is known to persons of ordinary skill in the art that molding yields a different microstructure than extruding and drawing, even though the extruded and molded parts may *look* similar from a macroscopic point of view. Applicants ask that the Examiner refer to pages 7 and 8, and in particular to Fig. 6 of the enclosed paper "Olefin Fiber". Fig. 6 of this paper clearly shows that the tenacity (strength) of polypropylene fiber increases with degree of stretching, implying that the microstructure of the polymer changes as a function of stretch. Applicants also ask that the Examiner review the enclosed Dupont® technical bulletin about Dupont® filaments. In the first paragraph of the second page, the bulletin states "thermal history, along with other variables like draw tensions and draw ratios, establish how the polymer molecule chains of the filament line up and crystallize." Thus, since molding yields a different microstructure than extruding and drawing, molding is a structural limitation and should be considered as such.

Courts have held that certain words that appear to be "process" words are more appropriately interpreted as structural limitations when they are used as an adjective in a non-process sense, and the words adequately define a physical characteristic of the product. For example, "intermixed" has been held to be a structural limitation (*National Battery Co. v. Richardson Co.*, 63 F. 2d 289, 17 U.S.P.Q. 60, 1933), and so has "ground in place" (*Ex parte Rabezzana*, 4 U.S.P.Q. 430, 1930) and "pressfitted" (*Ex parte Wagner*, 58 U.S.P.Q. 500, 1942). In a more recent case, it was held that "work-hardened" speaks to the structure and not to the process of manufacture (*CVI/Beta Ventures, Inc. v. Custom Optical Frames, Inc.*, 893 F. Supp. 508, 519, D. Md., 1995). Applicants respectfully submit that since "molded" is used as an adjective in a non-process sense, and since the word adequately defines a physical characteristic of the product, it should be afforded weight as a structural limitation. When "molded" is afforded weight, claim 52 and all dependent claims are patentable over the '128 reference discussed above.

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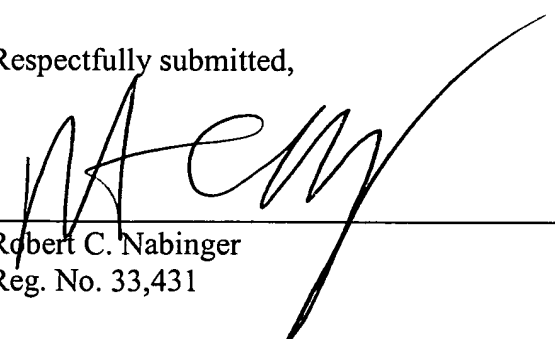
In addition, even if the claim can properly be construed as being a product by process claim, which the Applicants do not concede, it is clear that the structure implied by the alleged "process step" should be considered when assessing patentability. MPEP 2113 states

The structure implied by the process steps should be considered when assessing the patentability of product-by-process claims over the prior art, especially where the product can only be defined by the process steps by which the product is made, or where the manufacturing process steps would be expected to impart distinctive structural characteristics to the final product.

Applicants again submit that the '128 utility model does not disclose or suggest employing molded elastomeric elements, which are structurally distinguishable from the extruded elements of the prior art. As a result, claim 52 and all claims that depend therefrom are allowable. Applicants respectfully request a Notice of Allowance.

Enclosed is a check for \$450.00 for the Petition for Extension of Time fee. Please apply any other charges or credits to deposit account 06-1050, referencing Attorney Docket No. 00216-368004.

Respectfully submitted,



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Date: November 2, 2005

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants : Michael F. Roberts et al. Art Unit : 1744
Serial No. : 10/036,022 Examiner : Mark Spisich
Filed : December 26, 2001
Title : GUM-MASSAGING ORAL BRUSH

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Commissioner for Patents
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Alexandria, VA 22313-1450

REMARKS

An IDS is submitted herewith. The Notice of Appeal filed July 14, 2005 is hereby withdrawn so that a newly discovered reference, Salazar, U.S. Patent No. 5,535,474 may be considered. No claims have been amended since Applicants believe that all claims as presented in Applicants' Reply of March 8, 2005 are allowable. Applicants submit the following comments, and respectfully request reconsideration.

Claims 52-54 and 57 were rejected in the Final Office Action of April 26, 2005, and that rejection was maintained in the Advisory Action mailed June 28, 2005. The Examiner apparently believes that the above-noted claims are obvious over Japanese utility model JP 1-72128 ('128).

Independent claim 52 is directed to an oral brush, and requires at least one molded elastomeric element. Claims 53, 54 and 57 each depend from claim 52.

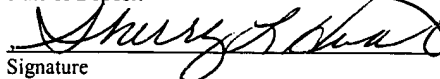
The '128 utility model discloses an oral cleaning implement employing filaments composed of an engineering elastomer that are extruded and drawn (melt spun). The '128 utility model does not disclose or suggest employing molded elastomeric elements, as claim 52 requires.

CERTIFICATE OF MAILING BY FIRST CLASS MAIL

I hereby certify under 37 CFR §1.8(a) that this correspondence is being deposited with the United States Postal Service as first class mail with sufficient postage on the date indicated below and is addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

November 2, 2005

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